

REMARKS

Applicants have considered the April 11, 2007 Office Action, and the comments that follow are presented in an effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1, 3-21 and 23-29 are pending in this application. Claim 29 has been withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). In response to the Office action dated April 11, 2007, independent claims 1 and 21 have been amended. Support for the claim amendments can be found at page 6, second paragraph and bridging paragraph of pages 8-9. No new matter has been added. Entry of the present response is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 1-3, 9-11, 15-21 and 23 were rejected under 35 U.S.C. § 102(b) as being anticipated over Yates (U.S. Pat. No. 5,715,648, hereinafter "Yates"). Applicants traverse the rejection.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. In imposing a rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. Moreover, there are significant differences between the claimed subject matter and the device disclosed by Yates that would preclude the factual determination that Yates identically describes the claimed subject matter within the meaning of 35 U.S.C. § 102.

Independent claim 1 has been amended to describe a high-speed envelope transport and packing system, wherein at the packing station, the conveyed open envelope and the object are in

simultaneous, same direction motion during insertion of the object into the conveyed open envelope.

Yates, at Fig. 3, discloses an inserting station 20 for inserting paper documents into a **waiting** envelope 24a at stop 54. See also col. 1, lines 60-65 and col. 2, lines 36-42. Yates fails to disclose or remotely suggest a high-speed envelope transport and packing system, wherein at the packing station, the conveyed open envelope and the object are in simultaneous, same direction motion during insertion of the object into the conveyed open envelope. The envelope in Yates inserting system is stationary at the time the paper documents are inserted into the envelope.

Independent claim 21 recites a high-speed envelope transport and packing system including a bending member configured to bend a conveyed envelope about the z-axis during conveyance of the conveyed envelope to increase the moment of inertia of the conveyed envelope about the z-axis above a corresponding moment of inertia of the conveyed envelope in a flat state. Independent claim 21 has been amended such that the recited moment of inertia is defined as the conveyed envelope's resistance to bending. In other words, during conveyance, the bent envelope's ability to resist bending is greater than the flat envelope's ability to resist bending. It is not apparent where Yates at FIGS. 1, 2 or 6, as alleged by the Examiner, discloses this claimed feature of independent claim 21. As described above, the envelope of Yates is stationary at stop 54 before it is opened/puckered and, therefore, the envelope is not being conveyed during its opening. Apparently, the envelop is conveyed in an unopened or unbent state. See Yates at col. 2, lines 36-60. Thus, the reference fails to teach every limitation of claim 21.

Thus, Yates fails to identically disclose or suggest every limitation of independent claim 1 and 21. Accordingly, Applicants submit that the Examiner's rejection under 35 U.S.C. § 102(b) is factually and legally erroneous and should be withdrawn.

Dependent claims 4-8, 12-14 and 24-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yates in view of Haas et al. (U.S. Pat. No. 4,780,040, hereinafter "Haas"). Applicants traverse.

Applicants incorporate herein the arguments previously advanced in traversal of the rejection under 35 U.S.C. § 102(b) predicated upon Yates. The secondary reference to Haas does not cure the deficiencies of Yates. Haas was relied upon by the Examiner for disclosing multiple vacuum ports. Adding such ports to Yates would still result in a system that at most bends the envelope while it is waiting at the packing station. Thus, even if the applied references are combined as suggested by the Examiner, the claimed pending subject matter will not result. Accordingly, the rejection is not legally viable and should be withdrawn for at least this reason.

Moreover, the patentability of dependent claim 3 is advocated. The bending member of claim 3 requires a rail disposed along a direction of conveyance of the open envelope in a position substantially corresponding to a center line of the conveyed open envelope with respect to a widthwise direction of the conveyed open envelope. Contrary to the Examiner's assertion, the hold down fingers 60, 62 in Yates are positioned off-center of the envelope, not substantially corresponding to a center line of the conveyed open envelope. See FIGS. 1 and 6.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an

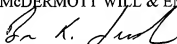
Application No.: 10/823,787

Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Brian K. Seidleck

Registration No. 51,321

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 BKS:dw
Facsimile: 202.756.8087
Date: September 11, 2007

**Please recognize our Customer No. 20277
as our correspondence address.**